

Application No. 10/755,022

REMARKS

Claims 1-33 are pending. By this Amendment, claims 1 and 2 are amended. The amendment to claim 1 is supported by the specification at, for example, page 17, lines 15-20 and by Figure 1. No new matter is introduced by the present Amendment. In a phone conversation with Examiner Joyce relating to a restriction requirement, the undersigned provisionally elected Group I, which corresponds to claims 1-13 and 22-33. However, all of the claims are currently pending, and Applicants thank the Examiner for examining all of the pending claims.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner asserted that, "in claim 1, there is insufficient structure to support the function 'achieves a sound...or better' in line 8." Applicants respectfully submit that "functional language does not, in and of itself, render a claim improper," and that functional limitations that set definite boundaries are acceptable. See MPEP § 2173.05(g). However, to advance prosecution of the present application, Applicants have amended claim 1 to include "a seal interposed between the single layer door assembly and the curb assembly, wherein the seal is capable of contacting the single layer door assembly and the curb assembly when in the closed orientation." Applicants submit that that claim 1 recites sufficient structure that contributes to the claimed sound transmission function, and that claims 1-13 are definite.

Since claims 1-13 are definite, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, as being indefinite.

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Rejections Under 35 U.S.C. § 102

The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,589,065 to Watson (the Watson Patent). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. Applicants submit that the Watson Patent does not disclose all the features of Applicants' claimed invention. Applicants respectfully request reconsideration of the rejection in view of the following comments.

The Watson Patent discloses a fire vent hatch having a housing and a cover pivotally secured to the housing. However, the Watson Patent does not disclose a hatch that, when in closed orientation, achieves a sound transmission class of STC-45 or better. In contrast, Applicants' invention, as claimed in independent claim 1, relates to an acoustical smoke vent wherein the acoustical smoke vent achieves a sound transmission class of STC-45 or better. Since the Watson Patent does not disclose this feature of Applicants' claimed invention, the Watson Patent does not anticipate Applicants' invention.

Since the Watson Patent does not anticipate Applicants' invention, as claimed in independent claim 1, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b) as being anticipated by the Watson Patent.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 2-9, 11-13 and 22-24 under 35 U.S.C. § 103(a) as being unpatentable over the Watson Patent in view of U.S. Patent 4,831,780 to Bockwinkel (the Bockwinkel Patent). In order to establish a *prima facie* case of obviousness, three basic criteria must be met. 'First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

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success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

With respect to claims 2-9 and 11-13, those claims all depend directly or indirectly from claim 1, and therefore incorporate all of the features of claim 1. As discussed above, claim 1 is patentable, and therefore Applicants respectfully request the withdrawal of the rejections of claims 2-9 and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over the Watson Patent in view of the Bockwinkel Patent.

With respect to claims 22-24, independent claim 22 relates to an acoustical smoke vent comprising means for acoustically insulating the smoke vent, when in the closed orientation to a sound transmission class rating of STC-45 or better. As discussed above, the Watson Patent relates to a fire vent hatch. However, the Bockwinkel Patent is directed towards a refrigerator door assembly having a seal between the door and the cabinet frame that prevents the entry of warm air into the refrigerated zone. In other words, the Bockwinkel Patent is directed towards the thermal efficiency of the refrigerator and not to sound dampening or sound reduction. Moreover, one of ordinary skill in the smoke vent art would not look to a disclosure relating to thermal efficiency of a refrigerator to reduce the sound transmission of a smoke vent. Thus, there is no motivation to combine the Watson Patent with the Bockwinkel Patent, and therefore the Examiner has failed to establish a prima facie case of obviousness. Since the combination of the Watson Patent and the Bockwinkel Patent do not render Applicants' invention, as claimed in independent claim 22, prima facie obvious, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) as being unpatentable over the Watson Patent in view of the Bockwinkel Patent.

The Examiner also rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over the Watson Patent in view of U.S. Patent 3,462,899 to Sherman (the Sherman Patent). Claim 10 depends directly from claim 1, and therefore incorporates all of the features of claim 1. As

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discussed above, claim 1 is patentable, and therefore Applicants respectfully request the withdrawal of the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over the Watson Patent in view of the Sherman Patent.

The Examiner also rejected claims 14-21 and 25-33 under 35 U.S.C. § 103(a) as being unpatentable over the Watson Patent in view of the Bockwinkel Patent and the Sherman Patent. More specifically, the Examiner asserted that, "Watson discloses the claimed invention except for the labyrinthine seal and the door having an inner portion. Bockwinkel teaches that it is known to provide a door with a labyrinthine seal." Additionally, the Examiner asserted that, "Watson discloses the claimed invention except for composite acoustic barrier material. Sherman teaches that is known to provide a door with composite material." Applicants submit that the combination of the Watson Patent, the Bockwinkel Patent and the Sherman Patent does not render Applicants' claimed invention prima facie obvious. Applicants respectfully request reconsideration of the rejection in view of the following comments.

Independent claim 14 relates to a method of acoustically insulating a smoke vent comprising interposing a labyrinthine seal between the door assembly and the curb assembly. As discussed above, there is no motivation to combine the Watson Patent and the Bockwinkel Patent. Additionally, the Sherman Patent does not disclose or suggest a Labyrinthine seal, and thus the combination of the Watson Patent and the Sherman Patent does not disclose or suggest all of the features of Applicants' claimed invention, as claimed in independent claim 14. Thus, The Examiner has failed to establish a prima facie case of obviousness. Since the combination of the Watson Patent, the Bockwinkel Patent and the Sherman Patent does not render independent claim 14 prima facie obvious, Applicant respectfully request withdrawal of the rejection of claims 14-21 under 35 U.S.C. § 103(a) as being unpatentable over the Watson Patent in view of the bockwinkel Patent in view of the Sherman Patent.

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Independent claim 25 relates to an acoustical smoke vent comprising a labyrinthine seal comprising a door portion operably coupled to the door assembly and a curb portion operably coupled to the curb assembly. As discussed above, there is no motivation to combine the Watson Patent with the Bockwinkel Patent. Additionally, the Sherman Patent does not disclose or suggest a labyrinthine seal, and thus the combination of the Watson Patent and the Sherman Patent does not disclose or suggest all of the features of Applicants' invention, as claimed in independent claim 25. Thus, the Examiner has failed to establish a prima facie case of obviousness. Since the combination of the Watson Patent, the Bockwinkel Patent and the Sherman Patent does not render Applicants' invention, as claimed in independent claim 25, prima facie obvious, Applicants respectfully request the withdrawal of the rejection of claims 25-33 under 35 U.S.C. § 103(a) as being unpatentable over the Watson Patent in view of the Bockwinkel Patent in view of the Sherman Patent.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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